

I. Objection to Claim 10

In paragraph 1 of the final Office action mailed February 27, 2003, the Examiner objects to claim 10 indicating that the recitation "progressively reveling information" should read "progressively revealing information". In response, applicants have amended claim 10 herein in accordance with the Examiner's suggestion.

II. Other Claim Amendments

Applicants have amended claim 10 herein to correct a minor typographical error by changing "d)" (second occurrence) to read "e)".

Claim 7 has also been amended herein by replacing the recitation "information being uncovered" with the recitation "information becoming visible". This amendment is believed to improve the antecedent basis for the terminology used in claim 7 relative to that used in claim 1.

III. Legal Basis for Prior Art Claim Rejections Applied in the Office Action

Legal Basis for Obviousness under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. In re Donovan, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. In re Rinehart, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered.

In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. In re Meng, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. In re Lintner, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat differently, the fact that inventions of the references and of applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975). It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g. Diamond International Corp. v. Walterhoefer, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); Ex parte Weber, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching

of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., Ex parte Hartmann, 186 USPQ 366 (Bd.App. 1974); and Ex parte Sternau, 155 USPQ 733

In the case of In re Wright, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicants' invention nor suggest the claimed combination as a solution to the problem which applicants' invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting In re Antle, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); In re Antonie, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the Specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., In re Rinehart, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on

the product created, rather than on the obviousness or notoriousness of its creation") (quoting General Motors Corp. v. U.S. Int'l Trade Comm'n, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. Rinehart, 531 F.2d at 1054, 189 USPQ at 149; see also In re Benno, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (Sup. Ct. 1966).

IV. 35 U.S.C. §103(a) Rejection of Claims 1-6 and 8-10

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marks (U.S. 6,097,390) and Nielsen (U.S. 6,337,699). Reexamination and reconsideration of the Examiner's rejection are requested.

At the outset, it is noted that, although the heading of the Examiner's rejection lists claims 1, 2, 5, 6, 8 and 10 (on page 2 of the Office action), the Examiner also discusses claims 3, 4 and 9 in the body of the rejection (on pages 3 and 4 of the Office action). Accordingly, applicants assume that the Examiner intended to reject claims 1-6 and 8-10 and not only claims 1, 2, 5, 6, 8 and 10. If this assumption is incorrect, then applicants request that they be provided with appropriate explanation and a reasonable opportunity to respond to the actual rejection intended by the Examiner.

Claims 1-6, 8 and 9

Applicants' claim 1 recites the following:

A progress monitor comprising:
a progress area used to indicate the progress of a process being monitored;
a progress indicator that progressively divides the progress area into a first part of the progress area and a second part of the progress area, where the first part of the progress area corresponds to the amount of completion of the process being monitored;
information, in addition to the progress of the process, progressively becoming visible in the first part of the progress area as the first part of the progress area becomes larger.

Claim 1 recites the following:

information ... progressively becoming visible in the first part of the progress area

The Examiner takes the position that Marks discloses this recitation. More specifically, the Examiner, with reference to Fig. 3 of Marks, states the following on page 2 of the Office action:

Marks teaches an indicator within the display bar designated for tracking progress (fig. 3; col. 3, lines 10-14). The area located left of the said indicator is used for tracking completion.

Applicants respectfully disagree with the Examiner's position. Referring to Fig. 3 of Marks, it can be appreciated that the area located to the left of the indicator (i.e., the darkened bar portion in Fig. 3), by itself, can convey no information whatsoever regarding the degree of completion of the process. Rather, it is only by observing the relationship between the left side and the right side that a viewer can determine the relative amount of progress of the process being performed. In other words, the size of the left side relative to the right side (or relative to the entire length of the left side plus the right side combined) conveys to a viewer the relative amount of progress of the process in Marks. The left side, by itself, however, would convey no information whatsoever.

This is in contrast to applicants' claim 1 which recites **"information ... progressively becoming visible in the first part of the progress area"**. Applicants disclose such information becoming progressively visible in the first part of the progress area, for example, with reference to applicants' Fig. 2 where information (e.g., text in the exemplary embodiment) is shown progressively becoming visible in the first part of the progress area. Clearly, Marks fails to disclose or suggest **"information ... progressively becoming visible in the first part of the progress area"** in this manner.

Claim 1 further recites the following:

information, in addition to the progress of the process, progressively becoming visible in the first part of the progress area

Claim 1, thus, requires information, *in addition to the progress of the process*, progressively becoming visible. Although, as discussed above, Marks may generally disclose progress indicators that indicate the progress of a process, Marks clearly does not disclose or suggest the display of information *in addition to the progress of the process* as recited in claim 1. Marks further clearly does not disclose that such additional information progressively become visible.

The Examiner states the following on pages 3-4 of the Office action:

Marks further teaches information, in addition to the progress of the process, progressively becoming visible in the first part the progress area as the first part of the progress area becomes larger (fig. 3; col. 3, lines 10-14).

The Examiner, thus, advances the position that Marks does disclose the display of information in addition to the progress of the process. The Examiner points to Fig. 3 of Marks to support this position. Fig. 3 of Marks, however, merely shows a "prior art" bar-type progress indicator in which a portion of a bar is darkened in proportion to the amount to which the process has progressed. The progress indicator of Marks Fig. 3 clearly does not show or suggest displaying any information *in addition to the progress of the process*.

The Examiner further points to col. 3, lines 10-14 of Marks to support the Examiner's position. This portion of Marks is reproduced below:

FIG. 3 is an illustration of an informational window that is used in prior-art computer systems to

indicate the progress of a task;
FIGS. 4A-4C are depictions of several
embodiments of pointer icons used in accordance with
the

The above-reproduced portion of Marks, at most, discusses the use of a progress indicator to provide a graphical expression of the progress of a process being performed. This portion of Marks clearly does not support the Examiner's assertion that Marks discloses that information, *in addition to the progress of the process*, progressively becomes visible in the first part the progress area.

If the Examiner intends to maintain the present rejection, then applicants respectfully request that the Examiner provide further explanation as to how the Examiner believes that Marks discloses the claim 1 recitation discussed above.

As set forth above, Marks does not disclose or suggest all of the limitations of claim 1. Clearly, Nielsen fails to remedy the inadequacies of Marks. Since the proposed combination of references fails to disclose or suggest all of the limitations of claim 1, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1.

Applicants further respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because there is no teaching or suggestion to combine the Marks and Nielsen references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

S.N. 09/234,255
Art Unit 2174
Atty Dkt 10980134-1

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d
953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

Claims 2-6, 8 and 9 are allowable at least as
depending from allowable base claim 1.

Claim 3 is allowable on further independent grounds
in that neither Marks, Nielsen nor any of the other
references of record, considered either alone or in
proper combination, disclose or suggest the progress
monitor of claim 1 and further where:

the progress area is a half circle

In support of the rejection of claim 3, the Examiner
points to Figs. 4a, 5a, 4c and 5c of Marks (see page 3 of
the Office action). None of these figures, however,
disclose or suggest a half circle as recited in claim 3.

Claim 4 is allowable on further independent grounds
in that neither Marks, Nielsen nor any of the other
references of record, considered either alone or in
proper combination, disclose or suggest the progress
monitor of claim 1 and further where:

the progress area is a half ellipse

In support of the rejection of claim 4, the Examiner
points to Figs. 4a, 5a, 4c and 5c of Marks (see page 3 of
the Office action). None of these figures, however,
disclose or suggest a half ellipse as recited in claim 4.

Claim 10

Applicants claim 10, as amended herein, recites the following:

A method of revealing information by a progress monitor during the monitoring of a process comprising the steps of:

- a) defining a progress area;
- b) dividing the progress area into a first part and a second part where the first part of the progress area corresponds to the amount of completion of the process being monitored;
- c) moving the dividing point between the first part and the second part of the progress area as the process progresses
- d) progressively revealing information in the first part of the progress area, as the first part of the progress area becomes larger;
- e) repeating steps c and d until the process being monitored has been completed.

Claim 10 recites the following:

progressively revealing information in the first part of the progress area, as the first part of the progress area becomes larger

In a manner similar to that advanced above, with respect to the rejection of claim 1, applicants

respectfully assert that Marks fails to disclose "progressively revealing information in the first part of the progress area". With reference, for example, to Fig. 3 of Marks, it can be appreciated that the area located to the left of the indicator (i.e., the darkened bar portion in Fig. 3), by itself, can convey no information whatsoever regarding the degree of completion of the process. Rather, it is only by observing the relationship between the left side and right side that a viewer can determine the relative amount of progress of the process being performed. In other words, the size of the left side relative to the right side (or relative to the entire length of the left side plus the right side combined) conveys to a viewer the relative amount of progress of the process in Marks. The left side, by itself, however, would convey no information whatsoever.

This is in contrast to applicants' claim 10 which recites "progressively revealing information in the first part of the progress area". Applicants disclose such information being progressively revealed in the first part of the progress area, for example, with reference to applicants' Fig. 2 where information (e.g., text in the exemplary embodiment) is shown progressively being revealed in the first part of the progress area. Clearly, Marks fails to disclose or suggest "progressively revealing information in the first part of the progress area" in this manner.

As set forth above, Marks does not disclose or suggest all of the limitations of claim 10. Clearly, Nielsen fails to remedy the inadequacies of Marks. Since the proposed combination of references fails to disclose or suggest all of the limitations of claim 10, the Examiner has failed to establish a *prima facie* case of

obviousness with respect to claim 10.

Applicants further respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because there is no teaching or suggestion to combine the Marks and Nielsen references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

V. 35 U.S.C. §103(a) Rejection of Claim 7

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Marks (U.S. 6,097,390) and Nielsen (U.S. 6,337,699) as applied to claim 1 and further in view of MS Outlook 97. Reexamination and reconsideration of the Examiner's rejection are requested.

Claim 7 is allowable at least as depending from allowable base claim 1.

Claim 7 is allowable on further independent grounds in that neither Marks, Nielsen, MS Outlook 97 nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the progress monitor of claim 1 and further where:

the information becoming visible is the next line of text in a story.

Applicants respectfully assert that the Examiner has

failed to establish a *prima facie* case of obviousness with respect to claim 7 because there is no teaching or suggestion to combine the Marks, Nielsen and MS Outlook 97 references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

Applicants further assert that the Examiner's rejection is improper because even the (improper) combination of references proposed by the Examiner fails to disclose or suggest the invention of claim 7. The Examiner states the following on page 5 of the Office action in support of the rejection of claim 7:

Marks and Nielsen fail to teach any type of uncovering that is the next line of text in a story. MS Outlook calendar provides a scroll bar that allows for the progressing through a calendar wherein the user can view a history (p. 23).

The Examiner, thus, admits that Marks and Nielsen fail to disclose the limitations of claim 7 but asserts that the MS Outlook 97 reference makes up for this deficiency with reference to page 23 thereof. Page 23 of the MS Outlook 97 reference generally discloses a scroll bar that allows a user to selectively view portions of a calendar page. The MS Outlook 97 reference clearly does not disclose or suggest a progress monitor in which information becoming visible is the next line of text in a story as recited in claim 7.

S.N. 09/234,255
Art Unit 2174
Atty Dkt 10980134-1

For the reasons set forth above, applicants assert
that all of the claims are allowable.

Respectfully submitted,
KLAAS, LAW, O'MEARA & MALKIN, P.C.

By 

Michael A. Goodwin, Reg. No. 32,697
KLAAS, LAW, O'MEARA & MALKIN, P.C.
1999 Broadway, Suite 2225
Denver, CO 80202
Telephone: (303) 298-9888
Fax: (303) 297-2266
Date: April 24, 2003

Version with Markings to Show Changes Made

In the claims:

Claim 7 has been amended as follows:

7) (once amended) The progress monitor of claim 1 where the information [being uncovered] becoming visible is the next line of text in a story.

Claim 10 has been amended as follows:

10) (twice amended) A method of [reveling] revealing information by a progress monitor during the monitoring of a process comprising the steps of:

- a) defining a progress area;
- b) dividing the progress area into a first part and a second part where the first part of the progress area corresponds to the amount of completion of the process being monitored;
- c) moving the dividing point between the first part and the second part of the progress area as the process progresses
- d) progressively [reveling] revealing information in the first part of the progress area, as the first part of the progress area becomes larger;
- [d] e) repeating steps c and d until the process being monitored has been completed.